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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,602	02/18/2004	Baruch Gedalia	006379.00005	2672
22908 7590 12/11/2008 BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606				
EXAMINER				
PAINTER, BRANON C				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
12/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/781,602

**Applicant(s)**

GEDALIA ET AL.

**Examiner**

BRANON C. PAINTER

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) 2, 9, 16 and 18 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 3-8, 10-15 and 17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of applicant's appeal brief filed on 09/03/08 and non-compliant response filed 09/24/08, PROSECUTION IS HEREBY REOPENED. The examiner's rejections are set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
  - (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.
3. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Brian E. Glessner/  
Supervisory Patent Examiner, Art Unit 3633.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

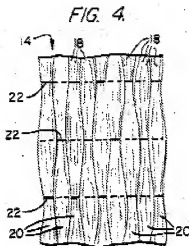
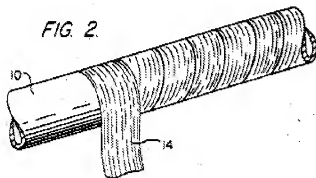
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 2-3, 5-8, 10, 12-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley (4,676,276) in view of Nishimura et al. (5,758,796).
7. Regarding claims 8 and 17:
- a. Fawley discloses a reinforced container including:
    - i. A metal container [claim 8] comprising a generally cylindrical container with a longitudinal axis [claim 17] (10, Fig. 2; Abstract).
    - ii. The container surrounded over at least part of its height with fiber fabric (14, Fig. 2) bonded to the external surface of the container (c. 4, 54-58).
    - iii. The fabric placed in bands extending substantially around the entire circumference of the container in a direction substantially perpendicular to the container axis, with the fibers of the fabric extending predominantly in a direction substantially perpendicular to the container axis (Figs. 2, 4; c. 4, 10-15).

- b. Fawley discloses the claimed invention wherein the fiber fabric is made from glass fibers instead of carbon fibers. Nishimura shows that glass fibers and carbon fibers an equivalent structure known in the art or reinforcing metal containers (c. 3, 37-39). Therefore, because these two reinforcement fibers were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the carbon fibers of Nishimura for the glass fibers of Fawley.
- c. The examiner notes it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
- d. The examiner notes that claim 17 is considered to be a product-by-process claim due to the phrase "passively bonded". The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).



Reproduced from Fawley

8. Regarding claim 10, Fawley/Nishimura as modified above discloses a metal container reinforced with carbon fibers, with Fawley further disclosing a container at least partly filled when wrapped with fabric (10 is filled with air, Fig. 2).
9. Regarding claim 12, Fawley/Nishimura as modified above discloses a metal container reinforced with carbon fibers, with Fawley further disclosing fabric bonded in several superposed layers (c. 3, 32-33; c. 4, 10-15; c. 8, 17-19).
10. Regarding claim 13, Fawley/Nishimura as modified above discloses a metal container reinforced with carbon fibers, with Fawley further disclosing a number of superposed layers varying with the container height (c. 4, 10-15; This passage states that when wrapping the overlap can be between 1-50%. For an overlap of 10%, the overlap portions are of greater thickness than the non-overlap portions).
11. Regarding claim 14, Fawley/Nishimura as modified above discloses a metal container reinforced with carbon fibers, with Fawley further disclosing superposed layers offset by half the width of a band (50% overlap; c. 4, 10-15).

12. Regarding claims 1, 3-7, and 15, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.
- a. Regarding claim 15, Fawley further discloses the limitation of passively surrounding the container with fiber fabric (c. 7, 42-55).
13. Claims 4 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Fawley/Nishimura as applied to claims 1, 2-3, 5-8, 10, 12-15, and 17 above, and further in view of Toth et al. (4,614,279).
14. Regarding claim 11:
- a. Fawley/Nishimura discloses a metal container reinforced with carbon fibers as set forth above.
- b. Fawley/Nishimura does not expressly disclose bonding the carbon fiber fabric to the container in such a manner to bypass regions projecting from the surface.
- c. Toth discloses a region projecting from a container surface, and fibers wrapped in a way that bypasses the container surface projection (c. 1, 51-62).
- d. The examiner notes that it is notoriously well-known for pipes such as Fawley to include secondary pipes projecting from the surface thereof, to carry the contents of the pipe in a secondary direction.
- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the carbon fiber fabric of Fawley/Nishimura

to bypass any container surface projections present as taught by Toth, in order to provide reinforcement to the area near such a projection.

15. Regarding claim 4, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination

### ***Response to Arguments***

16. Applicant's arguments filed 09/24/08 have been fully considered but they are not persuasive.
17. Applicant's arguments with respect to claims 1, 3-8, 10-15, and 17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

18. The examiner notes that a container is defined as "anything that contains or can contain something" (Dictionary.com).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./  
Examiner, Art Unit 3633

/Brian E. Glessner/  
Supervisory Patent Examiner, Art Unit 3633